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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/735,835

12/13/2000

Vernon Keith Boland

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26890

7590

05/19/2005

JAMES M. STOVER  
NCR CORPORATION  
1700 SOUTH PATTERSON BLVD, WHQ4  
DAYTON, OH 45479

EXAMINER

BORISSOV, IGOR N

ART UNIT

PAPER NUMBER

3639

DATE MAILED: 05/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/735,835

Applicant(s)

BOLAND ET AL.

Examiner

Igor Borissov

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-5,7-10,13,15-18 and 20-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5,7-10,13,15-18 and 20-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Response to Amendment***

Amendment received on 2/24/2005 is acknowledged and entered. Claims 6, 11, 12, 14 and 19 have been canceled. Claims 1, 5, 8, 9, 13, 18 and 21 have been amended. Claims 1-5, 7-10, 13, 15-18 and 20-24 are currently pending in the application.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 1-5 and 7-10 are rejected under 35 U.S.C. 101** because the claimed method for operating a business processing unit to generate a context for an interaction between a consumer and a business does not recite a limitation in the technological arts.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). See also MPEP 2106 II A which states that only when the claim is devoid of any limitation to a practical application "in the technological arts" should it be rejected under 35 U.S.C. 101. Hence, the first

test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

The "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

*The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. In re Toma at 857.*

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the

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"technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test.

In the decision of *AT&T Corp. v. Excel Communications Inc.*, 50 USPQ2d 1447, 1449-50 (Fed. Cir. 1999), it was recognized that not everything is statutory subject matter. The court noted that a mathematical algorithm or abstract idea is directed to non-statutory subject matter unless applied in a useful way or otherwise reduced to some type of practical application. The analysis in the *AT&T Corp* decision focused on whether or not the claimed mathematical algorithm was used to produce a useful, concrete and tangible result. AT&T's claimed process employs subscribers' and call recipients' primary interexchange carrier (PIC) indicator as data, applies Boolean algebra to those data to determine the value of the PIC indicator, and applies that value through switching and recording mechanisms to create a signal useful for billing

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purposes. The court noted that PIC indicator represents information about the call recipient's PIC, a useful, non-abstract result that facilitates differential billing of long-distance calls made by an IXC's subscriber, and therefore, found the claimed process to comfortably fall within the scope of Section 101. *AT&T Corp.*, 50 USPQ2d 1453. Again, *AT&T Corp.* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the court in *AT&T Corp.* recognized that the claims require the use of switches and computers. In *AT&T Corp.*, the decisions of *In re Alappat*, 33 F.3d 1526, 31 USPQ2d 1545 (Fed. Cir. 1994) and *Arrhythmia Research Tech. Inc. v. Corazonix Corp.*, 958 F.2d 1053, 1060, 22 USPQ2d 1033, 1039 (Fed. Cir. 1992) were also cited. In *Alappat* it was held that more than an abstract idea was claimed because the claimed invention as a whole was directed toward forming a specific machine that produced the useful, concrete and tangible result of a smooth waveform display. In *Alappat*, the claimed invention was for a machine that achieved certain results and was therefore, already considered to involve the technological arts. In *Arrhythmia*, the court reasoned that the method claims qualified as statutory subject matter by noting that the steps transformed physical, electrical signals from one form into another form – a number representing a signal related to the patient's heart activity, a non-abstract output.

This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

The claims of the present application are distinguished from the claims analyzed in the decisions of *State Street*, *Alappat*, *Arrhythmia* and *AT&T*, where the claims in these cases clearly involved the use of technology as shown below.

**State Street:** The claims were in means plus function form and directed to a data processing system for managing a financial services configuration of a portfolio established as a partnership; the claims included limitations of a computer processor means for processing data, a storage means for storing data on a storage medium along with first through fifth means for processing different types of financial data. As such, the claims analyzed in *State Street* clearly involved the technological arts and,

therefore, whether or not the claimed invention involved the technological arts was not an issue.

**AT&T Corp:** The claims were directed to a method for use in a telecommunications system in which interexchange calls initiated by each subscriber are automatically routed over the facilities of a particular one of a plurality of interexchange carriers associated with that subscriber comprising generating a message record for an interexchange call between an originating subscriber and a terminating subscriber, and including, in said message record, a primary interexchange carrier (PIC) indicator having a value which is a function of whether or not the interexchange carrier associated with said terminating subscriber is a predetermined one of said interexchange carriers. In considering these claims, it is clear that technology is being used to “automatically route” calls over the facilities of interexchange carriers and generating a message record for the call. Furthermore, the courts, in analyzing these claims, clearly indicated that they recognized the claims require the use of switches and computers. See *AT&T Corp. v. Excel Communications Inc.*, 50 USPQ2d at 1450 (Fed. Cir. 1999). The court further noted that AT&T’s claimed process employs subscriber’s and call recipients’ PICs as data, applies Boolean algebra to those data to determine the value of the PIC indicator, and applies that value through *switching and recording mechanisms* to create a signal useful for billing purposes. See *AT&T Corp. v. Excel Communications Inc.*, 50 USPQ2d at 1453 (Fed. Cir. 1999). As such, the claims analyzed in AT&T clearly involved the technological arts as recognized by the court and, therefore, whether or not the claimed invention involved the technological arts was not an issue.

**Alappat:** The claims were directed to a rasterizer for converting vector list data representing sample magnitudes of an input waveform into anti-aliased pixel illumination intensity data to be displayed on a display means comprising various means for determining distances and means for outputting illumination intensity data. Alappat’s invention related generally to a means for creating a smooth waveform display in a digital oscilloscope and as indicated by the court, Alappat’s invention is an improvement in an oscilloscope comparable to a TV having a clearer picture. The court reasoned

that invention was statutory because the claimed invention was directed to a "machine". See *In re Alappat*, 31 USPQ2d at 1552-54 (Fed. Cir. 1994). Furthermore, in the decision of *AT&T Corp.*, the courts recognized that the claims in *Alappat* were for a machine that achieved certain results. See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 50 USPQ2d at 1452 (CAFC 1999). Once again, these claims clearly involve the technological arts as recognized by the court and, therefore, whether or not the claimed invention involved the technological arts was not an issue.

**Arrhythmia:** The claims were directed to a method for analyzing electrocardiograph signals to determine the presence or absence of a predetermined level of high frequency energy in the late QRS signal including the step of converting a series of QRS signals to time segments, each segment having a digital value equivalent to the analog value of said signals at said time. In considering these claims, it is clear that technology is being used to convert a series of QRS signals to time segments having a digital value. Once again, these claims clearly involve the technological arts since one could not convert a signal to a time segment having a digital value without the aid of a computer or some processing device and, therefore, whether or not the claimed invention involved the technological arts was not an issue.

Contrary to the claims in the above-cited cases, the Claims in the present application are completely silent with regard to technology. The recited steps of *storing data*, *receiving data* and *accessing data* do not provide any indication that a computer or data processing device is being used to carry out the processes.

In accordance with MPEP 2106 (IV)(B)(2)(b) "Statutory Process Claims", not all processes are statutory under 35 U.S.C. 101. *Schrader*, 22 F.3d at 296, 30 USPQ2d at 1460. To be statutory, a claimed computer related process must either: (A) result in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan, or (B) be limited to a practical application within the technological arts. See *Diamond v. Diehr*, 450 U.S. at 183-184, 209 USPQ at 6 (quoting *Cochrane v. Deener*, 94 U.S. 780, 787-788 (1877)). The claims in the present application do not



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appear to satisfy either of the two conditions listed above. First, the claims do not include limitations that would suggest a computer is being used to transform the data from one form to another that would place the invention in the technological arts. Second, disregarding the fact that there is no computer claimed that would physically transform the data, there does not appear to be any physical transformation of data (i.e. *context*). The claims merely recite *storing data*, *receiving data* and *accessing data*. However, said *storing*, *receiving* and *accessing* steps appear not to alter said data, and can be understood as using a telephone for communication or using a computer for storing information. However, the claimed invention must utilize technology in a non-trivial manner (Ex parte Bowman, 61 USPQ2d 1665, 1671 (Bd. Pat. App. & Inter. 2001)). Although Bowman is not precedential, it has been cited for its analysis.

Thus, there neither appears to be any physical transformation of data from one form to another, which is based upon an algorithm or a calculation by a computer or processor, nor is there any technology claimed that would be used to transform the data.

As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) a network system, or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble.

Because the independently claimed invention is directed to an abstract idea which does not recite a limitation in the technological arts, those claims are not permitted under 35 USC 101 as being related to non-statutory subject matter. However, in order to consider those claims in light of the prior art, examiner will assume that those claims recite statutorily permitted subject matter.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-5, 7-13 and 15-24 are rejected under 35 U.S.C. 102(e) as being unpatentable over Gardenswartz et al. (6,298,330).**

Gardenswartz et al. (hereinafter Gardenswartz) teaches method and system for communicating with a customer's computer based on the offline purchase history of the consumer, comprising:

**Claims 1, 18 and 21.**

Storing customer purchase history information (*historical interaction data*) in a computerized, network-accessible database (C. 5, L. 39-41);

receiving current URL request (current interaction) from the customer over the Internet (C. 13, L. 58-60) to identify interaction data associated with previous customer purchase history information (C. 9, L. 57-60); said previous customer purchase history information including information which is relevant to the current interaction and including customer credit card number, social security card number, driver's license number, checking account number, shopper card number, shopper loyalty card number, customer's name, address and telephone number (C. 5, L. 56-61);

accessing said computerized, network-accessible database in accordance with the received current URL request to obtain said identified interaction data thereby providing interactive information which is relevant to the interaction with the customer (C. 9, L. 57-60).

Gardenswartz does not specifically teach that providing said interactive information which is relevant to the interaction with the customer includes providing a *context* for the communication received from the customer.

The Merriam-Webster Dictionary defines "context" as "the interrelated conditions in which something exists or occurs".

Therefore, it would have been obvious to one having ordinary skill in art the time the invention was made to modify Gardenswartz to include that said providing interactive information which is relevant to the interaction with the customer includes providing a *context* for the communication received from the customer, because without indication in the specification the advantages of using the term "context" over the prior art, it appears that said term "context" is obvious variation of said interactive information associated with a particular purchase history classification.

**Claims 2 and 20.** Receiving communication over the Internet (C. 13, L. 58-60).

**Claim 3.** Storing customer purchase history information in a database (C. 5, L. 39-41), and classifying said data into one or more purchase behavior classification (C. 7, L. 5-7).

**Claim 4.** Transmitting said purchase history data to the device (advertiser's server) through which the communication was received (C. 13, L. 58 – C. 14, L. 9).

**Claim 5.** Delivering said interactive information to the customer so that the customer can act upon receiving said information (C. 9, L. 31-38).

**Claim 7.** Said method, wherein the communication includes consumer identification data (C. 5, L. 55-61).

**Claim 8.** Gardenswartz teaches:

Storing customer purchase history information (*historical interaction data*) in a computerized, network-accessible database (C. 5, L. 39-41);

receiving current URL request (current interaction) from the customer over the Internet (C. 13, L. 58-60) to identify interaction data associated with previous customer purchase history information (C. 9, L. 57-60); said previous customer purchase history information including information which is relevant to the current interaction and including customer credit card number, social security card number, driver's license

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number, checking account number, shopper card number, shopper loyalty card number, customer's name, address and telephone number (C. 5, L. 56-61);

accessing said computerized, network-accessible database in accordance with the received current URL request to obtain said identified interaction data thereby providing interactive information which is relevant to the interaction with the customer (C. 9, L. 57-60).

Gardenswartz does not specifically teach that providing said interactive information which is relevant to the interaction with the customer includes providing a *context* for the communication received from the customer.

The Merriam-Webster Dictionary defines "context" as "the interrelated conditions in which something exists or occurs".

Therefore, it would have been obvious to one having ordinary skill in art the time the invention was made to modify Gardenswartz to include that said providing interactive information which is relevant to the interaction with the customer includes providing a *context* for the communication received from the customer, because without indication in the specification the advantages of using the term "context" over the prior art, it appears that said term "context" is obvious variation of said interactive information associated with a particular purchase history classification.

**Claim 9.** Receiving communication over the Internet (C. 13, L. 58-60).

**Claim 10.** Storing customer purchase history data (*historical interaction data*) in a database (C. 5, L. 39-41), and classifying said data into one or more purchase behavior classification (C. 7, L. 5-7).

**Claim 11.** Presenting interactive information for the customer, wherein said interactive information is associated with a particular purchase history classification so that the customer receives interactive information that reflects his or her offline purchase history (C. 9, L. 57-60).

**Claim 12.** Transmitting said purchase history data to the device (advertiser's server) through which the communication was received (C. 13, L. 58 – C. 14, L. 9).

**Claim 13.** Gardenswartz teaches:

Storing customer purchase history information (*historical interaction data*) in a computerized, network-accessible database (C. 5, L. 39-41);

receiving current URL request (current interaction) from the customer over the Internet (C. 13, L. 58-60) to identify interaction data associated with previous customer purchase history information (C. 9, L. 57-60); said previous customer purchase history information including information which is relevant to the current interaction and including customer credit card number, social security card number, driver's license number, checking account number, shopper card number, shopper loyalty card number, customer's name, address and telephone number (C. 5, L. 56-61);

accessing said computerized, network-accessible database in accordance with the received current URL request to obtain said identified interaction data thereby providing interactive information which is relevant to the interaction with the customer (C. 9, L. 57-60);

generating a response to the current URL request in accordance with the customer identification data, accessed customer purchase history information and interaction with the customer, delivering said response to the customer via e-mail (C. 7, L. 25).

Gardenswartz does not specifically teach that providing said interactive information which is relevant to the interaction with the customer includes providing a *context* for the communication received from the customer.

The Merriam-Webster Dictionary defines "context" as "the interrelated conditions in which something exists or occurs".

Therefore, it would have been obvious to one having ordinary skill in art the time the invention was made to modify Gardenswartz to include that said providing interactive information which is relevant to the interaction with the customer includes providing a *context* for the communication received from the customer, because without indication in the specification the advantages of using the term "context" over the prior

art, it appears that said term "context" is obvious variation of said interactive information associated with a particular purchase history classification.

Gardenswartz, also, does not specifically teach that said customer *request is received via e-mail*.

However, Gardenswartz does teach that said interactive information is delivered to the customer via e-mail (C. 7, L. 25), thereby suggesting interacting with the customer via e-mail.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify Gardenswartz to include that said customer request is received via e-mail, because it would advantageously allow to transmit said request almost instantly, thereby save time.

**Claims 15 and 16.** Retrieving by customer's computers Web pages of the registration server via the Internet (C. 6, L. 48-56), thereby indicating *generating a template e-mail on the customer's terminal*.

**Claim 17.** Storing customer purchase history data (*historical interaction data*) in a database (C. 5, L. 39-41) and classifying said data into one or more purchase behavior classification (C. 7, L. 5-7).

**Claim 19.** A computer configured to generate interactive information to the customer (C. 6, L. 47-64; C. 13, L. 58-60).

**Claims 22-24.** Said system as in claim 21. Language as to the specific content of the *interaction data, associated data and retrieved data* is given no patentable weight. MPEP 2106 (II) (C) states: "*Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.*"

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (bd Pat. App. & Inter. 1987).

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Thus the structural limitations of Claims 22-24 are disclosed by the prior art as described herein. Also, as described, the limitations of the claim do not distinguish the claimed apparatus from the prior art.

### ***Response to Arguments***

Applicant's arguments filed 2/24/2005 have been fully considered but they are not persuasive.

In response to applicant's argument that the amendment to the Claims obviate the Claim Rejections under 35 USC § 101, it is noted that storing data in a *computerized, network accessible database* indicates trivial use of technology. The recited steps of *storing data*, *receiving data* and *accessing data* do not provide any indication that a computer or data processing device is being used to carry out the processes.

The examiner maintains, that in accordance with MPEP 2106 (IV)(B)(2)(b) "Statutory Process Claims", not all processes are statutory under 35 U.S.C. 101. *Schrader*, 22 F.3d at 296, 30 USPQ2d at 1460. To be statutory, a claimed computer related process must either: (A) result in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan, or (B) be limited to a practical application within the technological arts. See *Diamond v. Diehr*, 450 U.S. at 183-184, 209 USPQ at 6 (quoting *Cochrane v. Deener*, 94 U.S. 780, 787-788 (1877)). The Claims in the present application do not appear to satisfy either of the two conditions listed above. First, the Claims do not include limitations that would suggest a computer is being used to transform the data from one form to another that would place the invention in the technological arts. Second, disregarding the fact that there is no computer claimed that would physically transform the data, there does not appear to be any physical transformation of data (i.e. *context*). Therefore, so as the independently claimed invention is directed to an abstract idea which does not recite a limitation in the

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technological arts, those Claims are not permitted under 35 USC 101 as being related to non-statutory subject matter.

In response to applicant's argument that information provided to the customer in Gardenswartz are based on stored purchase history information and does not have any relevancy with the current interaction, the examiner points out that Gardenswartz explicitly teaches that said stored purchase history information includes information which is relevant to the current interaction with the customer. Specifically, Gardenswartz teaches that said stored purchase history information includes customer credit card number, social security card number, driver's license number, checking account number, shopper card number, shopper loyalty card number, customer's name, address and telephone number (C. 5, L. 56-61).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.



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Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (571) 272-6801.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (571) 272-6812.

Any response to this action should be mailed to:


***Commissioner of Patents and Trademarks***

***Washington D.C. 20231***

or faxed to:

**(703) 872-9306**

[Official communications; including After Final  
communications labeled "Box AF"]

  
**THOMAS A. DIXON**  
**PRIMARY EXAMINER**

IB

5/13/2005